

ESTTA Tracking number: **ESTTA302200**

Filing date: **08/20/2009**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	U.S. Pole Company, Inc.
Granted to Date of previous extension	09/30/2009
Address	660 West Avenue O Palmdale, CA 93551 UNITED STATES
Attorney information	Gary J. Nelson Christie, Parker & Hale, LLP P.O. Box 7068 Pasadena, CA 91109-7068 UNITED STATES pto@cph.com Phone:626-795-9900

Applicant Information

Application No	79056058	Publication date	06/02/2009
Opposition Filing Date	08/20/2009	Opposition Period Ends	09/30/2009
International Registration No.	0970149	International Registration Date	06/26/2008
Applicant	Insta Elektro GmbH Wefelshohler StraÃ#e 35 58511 LÃ¼denscheid GERMANY		

Goods/Services Affected by Opposition

<p>Class 009.</p> <p>All goods and services in the class are opposed, namely: Scientific, electric, measuring, signaling, checking and supervision, and teaching apparatus and instruments, namely, home and office automation systems comprising wireless and wired controllers, controlled devices, and software for lighting, HVAC, security, safety and other home and office monitoring and control applications, electrical controllers</p>
<p>Class 011.</p> <p>All goods and services in the class are opposed, namely: Apparatus for lighting, namely, electric lighting fixtures, filters for lighting, flat panel lighting apparatus, landscape lighting installations, LED (light emitting diode) lighting fixtures, lighting tubes, optical lens covers that improve light output and uniformity, and protects the LED sold as a feature of an LED lighting system, electric and electronic lamps; light diffusers; guard devices for lighting, namely, protective covers for lighting devices</p>

Grounds for Opposition

Deceptiveness	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)
<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)
Other	Lack of bona fide intention to use the Mark in commerce

Mark Cited by Opposer as Basis for Opposition

U.S. Registration No.	3169307	Application Date	01/07/2003
Registration Date	11/07/2006	Foreign Priority Date	NONE
Word Mark	INSTALEZE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 011. First use: First Use: 2006/05/00 First Use In Commerce: 2006/05/00 ELECTRICAL LIGHTING PRODUCTS, NAMELY, ELECTRICAL LIGHTING FIXTURES FOR OUTDOOR USE		

Attachments	U68 110 2 5 Ntc of Oppos.pdf (6 pages)(205537 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Gary J. Nelson/
Name	Gary J. Nelson
Date	08/20/2009

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of trademark application **Serial No. 79/056,058**
For the mark INSTA
Published in the Trademark *Official Gazette* on June 2, 2009

U.S. POLE COMPANY, INC.	
	Opposer,
v.	
INSTA ELEKTRO GmbH	
	Applicant.

NOTICE OF OPPOSITION

U.S. POLE COMPANY, INC. ("U.S. Pole" or "Opposer"), a California corporation having a place of business at 660 West Avenue O, Palmdale, California 93551, believes that it will be damaged by registration of the mark shown in United States Trademark Application Serial No. 79/056,058 in International Classes 009 and 011, and hereby opposes its registration.

As grounds for opposition, Opposer alleges:

1. Applicant INSTA ELEKTRO GmbH ("Applicant" or "Insta Elektro") seeks to register the subject mark of United States Trademark Application Serial No. 79/056,058 (INSTA) ("the '058 Application") as a trademark for "SCIENTIFIC, ELECTRIC, MEASURING, SIGNALING, CHECKING AND SUPERVISION, AND TEACHING APPARATUS AND INSTRUMENTS, NAMELY, HOME AND OFFICE AUTOMATION SYSTEMS COMPRISING WIRELESS AND WIRED CONTROLLERS, CONTROLLED DEVICES, AND SOFTWARE FOR LIGHTING, HVAC, SECURITY, SAFETY AND OTHER HOME AND OFFICE MONITORING AND CONTROL APPLICATIONS, ELECTRICAL CONTROLLERS" in International Class 009; and for "APPARATUS FOR LIGHTING,

NAMELY, ELECTRIC LIGHTING FIXTURES, FILTERS FOR LIGHTING, FLAT PANEL LIGHTING APPARATUS, LANDSCAPE LIGHTING INSTALLATIONS, LED (LIGHT EMITTING DIODE) LIGHTING FIXTURES, LIGHTING TUBES, OPTICAL LENS COVERS THAT IMPROVE LIGHT OUTPUT AND UNIFORMITY, AND PROTECTS THE LED SOLD AS A FEATURE OF AN LED LIGHTING SYSTEM, ELECTRIC AND ELECTRONIC LAMPS; LIGHT DIFFUSERS; GUARD DEVICES FOR LIGHTING, NAMELY, PROTECTIVE COVERS FOR LIGHTING DEVICES" in International Class 011, claiming a bona fide intention to use the mark, as evidenced by the publication of said mark in the June 2, 2009 issue of the *Official Gazette*, and based on International Registration No. 0970149 pursuant to 15 U.S.C. § 1141f(a) [Section 66(a)].

2. Opposer is the owner of United States Trademark Registration No. 3,169,307 for INSTALEZE for "ELECTRICAL LIGHTING PRODUCTS, NAMELY, ELECTRICAL LIGHTING FIXTURES FOR OUTDOOR USE" in International Class 011 ("the '307 Registration"). The '307 Registration is on the Principal Register and issued on November 7, 2006. Opposer has been using this trademark since at least as early as May 2006. Opposer owns common law trademark rights in INSTALEZE throughout the United States for these same goods.

**First Ground for Opposition
Petitioner's Prior Trademark Rights and Likelihood of Confusion**

3. Opposer is in the business of selling electrical lighting products. Opposer uses the subject mark of the '307 Registration in association with the sale and marketing of these electrical lighting products. Opposer has invested a great deal of money and effort in using and promoting electrical lighting products in association with the subject mark of the '307 Registration and is continuing to extensively use and promote these goods in association with this same trademark.

4. As a result of the high quality of Opposer's goods and the extensive promotion, sales, and public acceptance thereof, Opposer's goods have acquired an outstanding reputation

and the public now uses the subject mark of the '307 Registration to distinguish Opposer's goods from the goods of others.

5. By virtue of the continuous, exclusive, and wide spread use by Opposer of the subject mark of the '307 Registration, this mark is entitled to a broad scope of protection.

6. Opposer's rights in the subject mark of the '307 Registration precedes any rights Applicant may have in its applied-for mark.

7. The mark for which Applicant has applied is nearly identical to the subject mark of the '307 Registration, at least as to visual appearance, commercial impression, and connotation.

8. The goods identified in International Classes 009 and 011 of Applicant's application are related, if not identical, to the goods identified in the '307 Registration. Applicant intends to use its applied-for mark on goods that compete directly or indirectly with goods sold or offered by Opposer.

9. The marketing and channels of trade associated with the goods identified in International Classes 009 and 011 of Applicant's application are closely related, if not identical, to the marketing and channels of trade within which Opposer sells and markets its goods associated with the subject mark of the '307 Registration.

10. Registration of Applicant's applied-for mark will likely cause confusion among the relevant consuming public and will likely cause the relevant consuming public to mistakenly conclude that Applicant's goods are associated with Opposer, when in fact they are not.

11. Registration of Applicant's applied-for mark is likely to cause injury to Opposer's business reputation and to injure and impair Opposer's rights in the subject mark of the '307 Registration by causing confusion, mistake, and/or deception as to the respective rights of the parties and as to the source or sponsorship of such goods.

12. Prior to the date Applicant filed the '058 Application (i.e., June 26, 2008), the relevant consuming public would have been confused as to the source or sponsorship of the subject mark of the '058 Application used in association with the corresponding goods listed in

International Classes 009 and 011, and would have believed Opposer to be the source of the goods.

Second Ground for Opposition
Fraud on the USPTO - No Bona Fide Intention to Use the Mark in Commerce

13. On information and belief, Applicant committed fraud on the United States Patent and Trademark Office ("USPTO") as part of its efforts to register the subject mark of the '058 Application. Applicant committed fraud when it filed the corresponding application under 15 U.S.C. § 1141f(a) [Section 66(a)], declaring that it had a "bona fide intention to use the mark in commerce" on all of the goods listed in International Classes 009 and 011.

14. On information and belief, Applicant made this declaration with full knowledge that it had no bona fide intention to use the mark in commerce on all of the goods listed in International Classes 009 and 011.

15. On information and belief, Applicant made this declaration with the intention to induce the USPTO to register the subject mark of the '058 Application, and the USPTO reasonably relied upon Applicant's declaration when approving the application for publication.

16. The USPTO's reliance, should it result in registration of Applicant's applied-for mark, is likely to cause injury to Opposer's business reputation and to injure and impair Opposer's rights in the subject mark of the '307 Registration by causing confusion, mistake, and/or deception as to the respective rights of the parties and as to the source or sponsorship of such goods.

17. Registration of Applicant's applied-for mark is inconsistent with the trademark rights of Opposer.

Third Ground for Opposition
Lack of Bona Fide Intention to Use the Mark in Commerce

18. On information and belief, Applicant did not have a bona fide intention to use the subject mark of the '058 Application in association with all of the goods listed in International

Classes 009 and 011 when it filed the corresponding application under 15 U.S.C. § 1141f(a) [Section 66(a)], declaring that it did indeed have a "bona fide intention to use the mark in commerce."

19. The registration of Applicant's applied-for mark, is likely to cause injury to Opposer's business reputation and to injure and impair Opposer's rights in the subject mark of the '307 Registration by causing confusion, mistake, and/or deception as to the respective rights of the parties and as to the source or sponsorship of such goods.

20. Registration of Applicant's applied-for mark is inconsistent with the trademark rights of Opposer.

WHEREFORE, Opposer prays that United States Trademark Application Serial No. 79/056,058 be rejected, and that the subject mark of this application for the goods identified in International Classes 009 and 011 be refused registration.

Respectfully submitted,

CHRISTIE, PARKER & HALE, LLP

Date

8/30/2009

By

Gary J. Nelson

Gary J. Nelson

Attorneys for Opposer

P.O. Box 7068

Pasadena, California 91109-7068

626/795-9900

Docket No. 110.2*5/U68

CERTIFICATE OF SERVICE

I certify that on August 20, 2009, the foregoing **NOTICE OF OPPOSITION** is being served by mailing a copy thereof by first-class mail addressed to:

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Wefelshohler Strasse 35
58511 Ludenscheid
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GJN/jjm

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